UNITED STATES PATENT AND TRADEMARK OFFICE

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09/667,779	09/22/2000	Nicolas Brogne	Q60742	1269

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EXAMINER
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ART UNIT	PAPER NUMBER
2151	

DATE MAILED: 07/05/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE _3_ MONTH(S) FROM
THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed
  after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any
  earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on _09 June 2005_.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is
closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) _1-12_ is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) _1-12_ is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage
application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☒ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
    Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____.

5)☐ Notice of Informal Patent Application (PTO-152)

6)☐ Other: _____.

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1.   A request for continued examination under 37 CFR 1.114, including the fee set

forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this

application is eligible for continued examination under 37 CFR 1.114, and the fee set

forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action

has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on

6/9/2005 has been entered. Claims 1-12 are presented for examination.

Claim Rejections - 35 USC § 102

2.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that

form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent
by another filed in the United States before the invention thereof by the applicant
for patent, or on an international application by another who has fulfilled the
requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before
the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act

of 1999 (AIPA) and the Intellectual Property and High Technology Technical

Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting

directly or indirectly from an international application filed before November 29, 2000.

Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior

to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

3.   Claims 1, 2, 11 and 12 are rejected under 35 U.S.C. 102(e) as being anticipated

by Nielsen (hereafter Nielsen), U.S. pat. No.5,870,548.

As to claim 1, Nielsen discloses a method of manipulating (modifying) a sent e-mail,

addressed by a sender to a plurality of addressees (recipients), said sent email

comprising an address header and a body (see fig.6B), wherein said method

comprising:

          routing a modification message (sending an action message to alter a previously

sent message) over a data network (sending a message over Internet, see col.6 lines

17-43) to a server (sender's email system 200 fig.2), that operates independently from

any e-mail processing means (sender email programs) associated with each of said

addressees (recipients) [enabling sender at the Email Control System to modify

message or delete a message after the message left the Email Control System (200

fig.2) to the remote Recipient Email System 202 fig.2 regardless of the sender email

programs, see col.6 lines 44-67] and on which at least the body of said sent e-mall is

stored, said modification message (409 fig.4) being sent by said sender (sender 407

fig.4) for modifying (altering) said e-mail body (using the senders programs to alter or to

modify a previously sent messages located at the Email Receiver, see abstract, figs.2,

4, col.7 line 2-65).

modifying said e-mail body (allowing a sender to modify a previously sent email

message) at said server (sender's email system 200 fig.2) according to said

modification message (if sender select to modify the message, taking the sender to the

modification path, see col.8 line 4 to col.9 line 22), if said e-mail body has not been

accessed (if the message was not seen/viewed by recipients) on said server by any of

said addressees (checking to see if the messages have been viewed by recipient, see

fig.10a, col.14 lines 16-64), wherein the modification of said e-mail body is denied if at

least one addressee has accessed said e-mail body on said server (treating the cancel

message/modify message as a normal message without modification from sender if the

recipients have seen the message, see col.14 line 65 to col.15 line 45 and col.16 lines

26-60), wherein the modification of said email body occurs at said server (sender's

email system) independently of any email processing means associated with each of

said addressees (recipients) [enabling sender to modify message or delete a message

after the message left the Email Control System (200 fig.2) to the remote Email

Receiver 202 fig.2 regardless of the sender email programs, see col.6 lines 44-67 and

col.18 lines 1-29]

As to claim 2, Nielsen discloses modification of said email consists in deleting said e-

mail body or modifying a part of said e-mail body (modifying or delete a email

message), said sender being informed by said server if said modification has been

executed or not (using a modify database to track previously sent messages have been

modified, see fig.8C, col.12 lines 39-64).

As to claim 11, Nielsen discloses a computer program product to be executed on a

computer comprising computer program code embodied on a computer-readable

medium, said computer program code means adapted to perform following steps:

composing a modification message (receiving a message containing a X-modify

field including request for modifying a email message, see fig.11A, col.15 lines 41-51)

for modifying an e-mail addressed to a plurality of addressees (e-mail recipients) and

sent to a predefined server (200 fig.2) (see col.15 line 52 to col.16 line 25).

sending said modification message to said server to modify at least the body of

the email sent to (modifying or deleting email message including the body) and stored

on said predefined server if the email body has not been accessed on said server by

any of addressee (modifying the previous sent email message if the message has not

been seen, see fig.11B, col.16 line 61 to col.17 line 22), wherein the modification of said

e-mail body is denied if at least one addressee has accessed said e-mail body on said

server (treating the cancel message/modify message as a normal message if the

recipients have seen the message, see col.14 line 65 to col.15 line 45 and col.16 lines

26-60) and wherein the modification of said email body occurs at said server (sender's

email system) independently of any email processing means associated with each of

said addressees (recipients) [enabling sender to modify message or delete a message

after the message left the Email Control System to the remote Email Receiver

regardless of the sender email programs, see col.6 lines 44-67 and col.18 lines 1-29].

As to claim 12, Nielsen discloses a personal computer equipped with a computer

program according to claim 11, computer program to be executed on a computer

comprising computer program code embodied on a computer-readable medium, said

computer program code means adapted to perform following steps:

composing a modification message (receiving a message containing a X-modify

field including request for modifying a email message, see fig.11A, col.15 lines 41-51)

for modifying an e-mail addressed to a plurality of addressees (e-mail recipients) and

sent to a predefined server (200 fig.2) (see col.15 line 52 to col.16 line 25).

sending said modification message to said server to modify at least the body of

the email sent to (modifying or deleting email message including the body) and stored

on said predefined server if the email body has not been accessed on said server by

any of addressee (modifying the previous sent email message if the message has not

been seen, see fig.11B, col.16 line 61 to col.17 line 22), wherein the modification of said

e-mail body is denied if at least one addressee has accessed said e-mail body on said

server (treating the cancel message/modify message as a normal message without

modification if the recipients have seen the message, see col.14 line 65 to col.15 line 45

and col.16 lines 26-60) and wherein the modification of said email body occurs at said

server (sender's email system) independently of any email processing means

associated with each of said addressees (recipients) [enabling sender to modify

message or delete a message after the message left the Email Control System to the

remote Email Receiver regardless of the sender email programs, see col.6 lines 44-67

and col.18 lines 1-29].

Claim Rejections - 35 USC § 103

4.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set
> forth in section 102 of this title, if the differences between the subject matter sought to be patented and
> the prior art are such that the subject matter as a whole would have been obvious at the time the
> invention was made to a person having ordinary skill in the art to which said subject matter pertains.
> Patentability shall not be negatived by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the

claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the

various claims was commonly owned at the time any inventions covered therein were

made absent any evidence to the contrary. Applicant is advised of the obligation under

37 CFR 1.56 to point out the inventor and invention dates of each claim that was not

commonly owned at the time a later invention was made in order for the examiner to

consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g)

prior art under 35 U.S.C. 103(a).

5.   Claims 3-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over

Nielsen in view of Uchida et al. (hereafter Uchida), U.S. pat. No.6,327,610.

As to claim 3, Nielsen discloses a server (email system 200 fig.2) to be part of an e-mail

system, said server being able to receive, from a data network (Internet 200 fig.2), an e-

mail comprising an address header and a body by a sender (sender) to a plurality of

addressees (recipients), said server comprising:

storing the body of a received e-mail (email system receiving a email message

containing X-modify, see col.15 lines 45-52) together with an authentication protection

(authentication protection including in the header of an email message, see col.10 lines

21-51) on said server (Email Control System 200 fig.2).

sending to each addressee (recipient) of said e-mail a notification (confirmation

message) containing the access code for accessing said e-mail body (using database

1104 fig.11A to check for a matching entry, see fig.11A, col.15 line 51 to col.16 line 5)

handling a status storage (database 1105 fig.11A) indicating at least whether

said e-mail body has been accessed by one of said addressees (maintaining

information in the database if the recipient has seen the message, see col.16 lines 6-

25).

if a modification message for modifying said e-mail body is received, modifying

said e-mail body according to said modification message (modifying or deleting

message), if said e-mail body has not been accessed on said server by any of said

addressees [modifying the previous sent email message if the message has not been

seen, see fig.11B, col.14 lines 22-64 and col.16 line 61 to col.17 line 22], wherein the

modification of said email body occurs at said server (sender's email system)

independently of any email processing means associated with each of said addressees

(recipients) [enabling sender to modify message or delete a message after the message

left the Email Control System to the remote Email Receiver regardless of the sender

email programs, see col.6 lines 44-67] and wherein the modification of said e-mail body

is denied if at least one addressee has accessed said e-mail body on said server

(treating the cancel message/modify message as a normal message if the recipients have seen the message, see col.14 line 65 to col.15 line 45 and col.16 lines 26-60). Nielsen suggests using an authentication protection to protect the access to email messages (using authentication protection facility in the headers of email message). Nielsen does not specifically disclose an access code. However, Uchida in the same broadcasting electronic mails in the Internet discloses an access code, storing an access code as a key for access to the electronic mail, see Uchida's fig.2, col.6 line 54 to col.7 line 24). It would have been obvious to one of the ordinary skill in the art at the time the invention wad made to implement an access code in the computer system of Nielsen to protect the privacy of email messages because it would have enabled prevention of enormous traffic at a network caused by distribution of electronic mail (see Uchida's col.3 lines 9-22) and thus protected the privacy of electronic email distribution in a communications network.

As to claim 4, Nielsen discloses sending a message to the sender of said modification message to notify the sender if the modification has been executed or not (using a modify database to track if previously sent messages have been modified, see fig.8C, col.12 lines 39-64 and col.14 lines 45-64).

As to claim 5, Nielsen disclose sending a message to the sender of said e-mail containing authentication information associated to said e-mail (sender storing a modify message including authentication header for providing a previous sent email message,

see figs.2, 7B, col.10 lines 21-51). Nielsen suggests using an authentication protection

to protect the access to email messages (using authentication protection facility in the

headers of email message). Nielsen does not specifically disclose an access code.

However, Uchida in the same broadcasting electronic mails in the Internet discloses an

access code, storing an access code as a key for access to the electronic mail, see

Uchida's fig.2, col.6 line 54 to col.7 line 24). It would have been obvious to one of the

ordinary skill in the art at the time the invention wad made to implement an access code

in the computer system of Nielsen to protect the privacy of email messages because it

would have enabled prevention of enormous traffic at a network caused by distribution

of electronic mail (see Uchida's col.3 lines 9-22) and thus protected the privacy of

electronic email distribution in a communications network.

As to claim 6, Nielsen discloses downloading said e-mail body to one of said addressee

(recipient) providing an authentication and deleting said e-mail body at said server when

each one of said addressees has accessed said e-mail body at said server (email

system) (modify or deleting a message according to how long the messages have been

inactive and checking to see if the messages have been viewed by recipient, see col.12

line 39 to col.13 line 6). Nielsen suggests using an authentication protection to protect

the access to email messages (using authentication protection facility in the headers of

email message). Nielsen does not specifically disclose an access code. However,

Uchida in the same broadcasting electronic mails in the Internet discloses an access

code, storing an access code as a key for access to the electronic mail, see Uchida's

fig.2, col.6 line 54 to col.7 line 24). It would have been obvious to one of the ordinary

skill in the art at the time the invention wad made to implement an access code in the

computer system of Nielsen to protect the privacy of email messages because it would

have enabled prevention of enormous traffic at a network caused by distribution of

electronic mail (see Uchida's col.3 lines 9-22) and thus protected the privacy of

electronic email distribution in a communications network.

As to claim 7, Nielsen discloses storing the header of said e-mail and executing an

authentication procedure (using an authentication header information in the modify

message) when a user tries to access said e-mail body (see figs.2, 6A-6D, 7A, col.7 line

40 to col.8 line 59, col.9 lines 22-67 and col.10 line 21 to col.11 line 43). Nielsen

suggests using an authentication protection to protect the access to email messages

(using authentication protection facility in the headers of email message). Nielsen does

not specifically disclose an access code. However, Uchida in the same broadcasting

electronic mails in the Internet discloses an access code, storing an access code as a

key for access to the electronic mail, see Uchida's fig.2, col.6 line 54 to col.7 line 24). It

would have been obvious to one of the ordinary skill in the art at the time the invention

wad made to implement an access code in the computer system of Nielsen to protect

the privacy of email messages because it would have enabled prevention of enormous

traffic at a network caused by distribution of electronic mail (see Uchida's col.3 lines 9-

22) and thus protected the privacy of electronic email distribution in a communications

network.

As to claim 8, Nielsen discloses storing the header of said e-mail and receiving a modification message (generating required headers after receiving an action message, see col.9 lines 23-42), dedicated to modifying said e-mail header only OR said e-mail body (modifying said email body) and modifying said e-mail header according to said modification message (modifying or cancel message in the e-mail's header, see figs.7A, col.9 lines 23-67), if said e-mail has not been accessed by any of said addressees (if the message is not viewed by recipient by using a message seen field, see fig.8B, col.10 lines 21-48 and col.12 lines 5-38).

As to claim 9, Nielsen discloses storing the header of said e-mail and sending to said addressees an e-mail containing said e-mail header and said e-mail body after a predefined time period (a week) (deleting email message if it has been inactive for more than a week) and deleting (deleting message) at said server said e-mail header and said e-mail body (see fig.8C, col.12 line 39 to col.13 line 23).

As to claim 10, Nielsen discloses a computer program product to be executed on a server according to claim 3, said computer program product comprising means embodied on a computer-readable medium and adapted to perform a method of modifying an email comprising an address header (header field of the message) and a body and sent to a plurality of addressees (recipients), said method comprising:

storing the body of a received e-mail (email system receiving a email message

containing X-modify, see col.15 lines 45-52) together with an authentication protection

(authentication protection including in the header of an email message, see col.10 lines

21-51) on said server (Email Control System 200 fig.2) and sending to each addressee

(recipient) of said e-mail a notification (confirmation message) containing the access

code for accessing said e-mail body (using database 1104 fig.11A to check for a

matching entry, see fig.11A, col.15 line 51 to col.16 line 5), handling a status storage

(database 1105 fig.11A) indicating at least whether said e-mail.body has been accessed

by one of said addressees (maintaining information in the database if the recipient has

seen the message, see col.14 lines 22-64 and col.16 lines 6-25) and if a modification

message for modifying said e-mail body is received, modifying said e-mail body

according to said modification message (modifying or deleting email message including

the body), if said e-mail body has not been accessed on said server by any of said

addressees [modifying the previous sent email message if the message has not been

seen, see fig.11B, col.16 line 61 to col.17 line 22], wherein the modification of said e-

mail body is denied if at least one addressee has accessed said e-mail body on said

server (treating the cancel message/modify message as a normal message without

modification if the recipients have seen the message, see col.14 line 65 to col.15 line 45

and col.16 lines 26-60) and wherein the modification of said email body occurs at said

server (sender's email system) independently of any email processing means

associated with each of said addressees (recipients) [enabling sender to modify

message or delete a message after the message left the Email Control System to the

remote Email Receiver regardless of the sender email programs, see col.6 lines 44-67

and col.18 lines 1-29].

Nielsen suggests using an authentication protection to protect the access to

email messages (using authentication protection facility in the headers of email

message). Nielsen does not specifically disclose an access code. However, Uchida in

the same broadcasting electronic mails in the Internet discloses an access code, storing

an access code as a key for access to the electronic mail, see Uchida's fig.2, col.6 line

54 to col.7 line 24). It would have been obvious to one of the ordinary skill in the art at

the time the invention wad made to implement an access code in the computer system

of Nielsen to protect the privacy of email messages because it would have enabled

prevention of enormous traffic at a network caused by distribution of electronic mail

(see Uchida's col.3 lines 9-22) and thus protected the privacy of electronic email

distribution in a communications network.

Response to Arguments

6.   Applicant's arguments filed on 6/9/2005 have been fully considered but they are

not persuasive.

        a.   Applicant asserts that the cited reference does not disclose the applicant'

        claimed invention "wherein the modification of said e-mail body is denied if at

        least one addressee has accessed said e-mail body on said server".

Examiner respectfully disagrees. Examiner points out that the Nielsen

reference still discloses that the modification of said e-mail body is denied if at

least one addressee has accessed said e-mail body on said server (treating the

cancel message/modify message as a normal message without modification if

the recipients have seen the message, see col.14 line 65 to col.15 line 45 and

col.16 lines 26-60) as rejected above.

Other prior art cited

7.   The prior art made of record and not relied upon is considered pertinent to
applicant's disclosure.

   a. Sidhu et al, US pat. No.5,734,901.

   b. Ralston et al, US pat. No.6,842,773.

   c. Donaldson, US pat. No.6,321,267.

Conclusion

8.   Claims 1-12 are rejected.

9.   Any inquiry concerning this communication or earlier communications from the examiner should be directed to Khanh Dinh whose telephone number is (571) 272-3936. The examiner can normally be reached on Monday through Friday from 8:00 A.m. to 5:00 P.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Zarni Maung, can be reached on (571) 272-3939. The fax phone number for this group is (703) 872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Khanh Dinh
Patent Examiner
Art Unit 2151
6/21/2005